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## REMARKS

Claims 2-10, 12-13, 20-22, 25-26, 29-30, and 35-54 are pending. Claim 45 stands rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. Claims 2-4, 20, 35, and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,561,017 to Greene. Claims 5, 8-10, 21, 37, 41, and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 4,346,260 to Kaufmann. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 5,812,274 to Inuzuka et al. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 6,456,319 to Hirasawa et al. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 5,604,418 to Filo. Claims 13, 22, 25-26, 29-30, 36, and 49-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 4,952,051 to Lovell et al. Claims 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 5,532,711 to Harris. Claims 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 5,532,711 to Harris and U.S. Patent No. 5,581,158 to Quazi. Claims 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 6,590,548 to Mizutani et al. Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 5,742,279 to Yamamoto et al. and U.S. Patent No. 6,676,411 to Rehkemper. Claim 44 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 5,742,279 to Yamamoto et al., U.S. Patent No. 6,676,411 to Rehkemper, and U.S. Patent No. 5,730,602 to Gierhart et al. Claims 46-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 4,952,051 to Lovell et al. and U.S. Patent No. 5,742,279 to Yamamoto et al. Claim 48 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,561,017 to Greene in view of U.S. Patent No. 4,952,051 to Lovell et al., U.S. Patent No. 5,742,279 to Yamamoto et al., and U.S. Patent No. 5,730,602 to Gierhart et al. Claims 42 stands objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 5-7, 13, 22, 26, and 43 are amended. Claims 55-56 are added. Claims 3-4, 8-10, 12, 20-21, 25-26, 29-30, 35, 37, 40, 42, 44, and 49-52 are canceled. Claims 7, 13, 22, 36, 38-39, 41, 43, 45-48, and 53-58 remain in the case for consideration.

Claim 55 is previous claim 42 rewritten in independent form, which is hereby canceled. Accordingly, claim 55 should now be allowable.

#### REJECTIONS UNDER 35 U.S.C. § 112, ¶ 2

The Examiner rejected claim 45 as indefinite for failing to particularly point out and distinctly claim that which the Applicant regards as the invention. The Applicant believes the claim is clear. Understanding can be found in the specification at page 3, line 23 through page 4, line 8. As described therein, "drawing tablet 105 may project light segments onto surface 110. These projected light segments may be used, for example, to teach a student how to write. . . . Software (not shown in FIG. 1) may be used to compare the image captured by imaging sensor 130 with the location of projected light segment 145. If the image shows a line close in position and shape to projected light segment 145, the user may be rewarded. . . ." The Applicant believes this description defines clearly what claim 45 is directed toward, and that claim 45 is therefore not indefinite.

#### REJECTIONS UNDER 35 U.S.C. § 103(a)

Referring to claim 7, the Examiner argued that Hirasawa teaches adjusting an image to compensate for a reversed image. In fact, Hirasawa teaches changing a negative image into a positive image with film. While technically reversing an image, this is in fact only reversing the color of the image.

To help clarify the focus of claim 7, claim 7 has been amended to describe the software as compensating for a mirror image. (Claim 7 has also been amended to include the limitations of parent claim 2, now canceled.) As Hirasawa does not teach compensating for a mirror image, claim 7 is not obvious over Greene in view of Hirasawa. Accordingly, claim 5-7 should now be allowable.

Referring to claims 13, 22, and 36, the Examiner acknowledged that Greene does not teach software to animate a portion of the image. The Examiner cited to Lovell for this feature. But, as argued before, Lovell is not analogous prior art. Greene is a drawing tablet; Lovell is an apparatus for producing animated drawings.

The Examiner has argued that he believes Lovell to be analogous art, and that under *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992), the prior art must either be in the field of the Applicant's endeavor or reasonably pertinent to the problem. The Examiner asserts that Lovell satisfies both of these requirements; the Applicant disagrees. The field of endeavor in this invention is drawing tablets; Lovell, in contrast, is a system for animation. Accordingly, Lovell is not in the Applicant's field of endeavor. Furthermore, in Lovell, animation is accomplished by the Applicant hand-drawing the images to be animated. In contrast, in the invention, the user demonstrates to the drawing tablet what is to be animated, but leaves it to the drawing tablet to actually perform the animation. In other words, the user is not specifying a set of images that are to be assembled in a particular sequence; the user is providing a much higher level of abstraction, and leaving the detail work to the invention.

It is also worth noting that, even though Lovell relates to animation, this fact by itself is not enough to show that it is pertinent to the problem addressed by the invention. In *Oetiker*, the court held that the Examiner failed to establish the motivation for someone interested in fastening a hose clamp to look to the field of fasteners for garments for a solution. *Oetiker*, 24 U.S.P.Q.2d 1445-46. And in *Oetiker*, both the invention and the prior art related to fasteners (albeit of different sorts). Here, the invention is, before it is anything else, a drawing tablet. Lovell, as a system for producing animations, is not pertinent art with reference to drawing tablets. The Applicant argues again that Lovell is not analogous prior art, and that the Examiner is using hindsight to render the claims obvious.

The amendments to claims 13 and 22 do not change the scope of the claims. Claim 13 has been amended to include the limitations of parent claim 2, and claim 22 has been amended to include the limitations of parent claim 20; parent claims 2 and 20 have been canceled. Accordingly, claims 13, 22, and 36 are patentable under 35 U.S.C. § 103(a) over Greene in view of Lovell, and claims 13, 22, 36, 53, and 57-58 are allowable.

New claim 56 is similar to claim 22, but refers to playback of recorded motion as opposed to animating a portion of the image. As none of the references teach or suggest playing back recorded motion, claim 56 is allowable.

Referring to claims 38-39, the Applicant asserts again that Greene, Harris, and Quazi are not analogous art. Greene teaches a drawing tablet, Harris a lightweight display system, and Quazi a lamp brightness control circuit. Only Greene potentially lies within the field of endeavor of the Applicant; a person skilled in the art would not look to the fields of endeavor of Harris or Quazi to solve problems associated with drawing tablets. As held by the court in *Oetiker*, the Examiner needs to show a motivation in the prior art to someone skilled in the

field of the invention to look to other fields to utilize teachings in those other fields. The Applicant asserts that the Examiner has failed to meet this burden. The amendment to claim 38 does not change its scope, only introducing the limitations of parent claim 37, which has been canceled. Accordingly, claims 38-39 are patentable under 35 U.S.C. § 103(a) over Greene in view of Harris, and Greene in view of Harris and Quazi, respectively, and therefore are allowable.

Referring to claim 41, the Examiner acknowledged that Greene does not teach "light projecting means". The Examiner cited to Kaufman for this feature. But the feature claimed in claim 41 is not "light projecting means": it is "projecting a light line onto the drawing tablet". In other words, the light is not being projected onto the entire surface of the drawing tablet. But Kaufmann only teaches a light source that "illuminate[s the] picture on the drawing table surface" (column 2, lines 42-43). Greene and Kaufmann do not teach or suggest all the features of claim 41. Accordingly, claim 41 is patentable under 35 U.S.C. § 103(a) over Greene in view of Kaufman, and claims 41 and 54 are therefore patentable.

Claim 43 has been amended to incorporate the limitation of claim 44, thus claim 43 is treated as rejected under 35 U.S.C. § 103(a) as unpatentable over Greene in view of Yamamoto, Rehkemper and Gierhart. Referring to claims 43 and 48, the Examiner has provided an incomplete rejection, acknowledging that Greene, Yamamoto, and Rehkemper fail to teach all of the features of claim 44, and acknowledging that Greene, Lovell, and Yamamoto fail to teach all of the features of claim 48, but failing to indicate how Gierhart teaches the missing features of claim 43 and 48. Gierhart is a system for teaching handwriting. Various data are captured about pen usage. If there are problems with the user's use of the pen, immediate feedback can be provided.

First of all, Gierhart does not detect a change in an image. Gierhart is only concerned with pen tilt angle, pressure, position, height, etc. at a given moment in time. The only data captured by Gierhart that has to do with change the handwriting lies in the timing for each pixel: in other words, has the user moved the pen too fast or too slow. But this is not a change in the image: this is a change in the pen. And every other datum relates only to whether the pen, in its current position, orientation, etc., is correct for where the user ought to be. Thus, Gierhart does not identify a change in the contents of the image. As the Examiner has acknowledged that Greene, Yamamoto, and Rehkemper also fail to teach this feature, claim 43 is patentable under 35 U.S.C. § 103(a) over Greene in view of Yamamoto, Rehkemper, and Gierhart. And the Examiner has acknowledged that Greene, Lovell, and Yamamoto also fail to teach this feature, claim 48 is patentable under 35 U.S.C. § 103(a) over

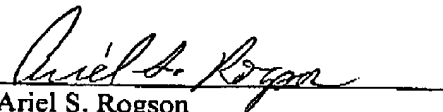
Greene in view of Lovell, Yamamoto, and Gierhart. Accordingly, claims 43 and 48 are allowable.

Referring to claims 46-47, the Examiner has argued that Yamamoto teaches modifying received images based on the contents of the image or a prior image, and displaying the modified image. The Applicant first argues that Yamamoto is a very poorly written reference. The Applicant believes that Yamamoto fails to satisfy 35 U.S.C. § 112, ¶ 1, in that the specification is unclear and fails to enable a person skilled in the art to make and use the invention. As a non-enabling reference, Yamamoto cannot be used to teach a feature of the claims the Examiner has acknowledged is not taught by other references.

But even if Yamamoto is enabling, the Applicant argues that Yamamoto fails to teach the features of the claims. At column 2, lines 39-46, Yamamoto describes the invention as including "image extraction means for automatically extracting only a required portion from image input information through the image input means; . . . and image synthesize means for combining the image with an image which is already displayed and stored . . . ." Thus, Yamamoto might teach modifying an image through this image synthesis. But this "modification" is not based on the contents of image, or a change from a prior image. Accordingly, Greene, Lovell, and Yamamoto all fail to teach features of the claims, and claims 46-47 should therefore be allowable under 35 U.S.C. § 103(a) over Greene in view of Lovell and Yamamoto, and claims 46-48 should be allowable.

For the foregoing reasons, reconsideration and allowance of claims 5-7, 13, 22, 36, 38-39, 41, 43, 45-48, and 53-58 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,  
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